

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION**

GEOTAG, INC.,	§	
	§	
Plaintiff,	§	
	§	
v.	§	
	§	
FRONTIER COMMUNICATIONS CORP., ET AL.	§	CASE NO. 2:10-CV-265
	§	(LEAD CASE)
YELLOWPAGES.COM, LLC, ET AL.	§	CASE NO. 2:10-CV-272
GEORGIO ARMANI S.P.A., ET AL.	§	CASE NO. 2:10-CV-569
AROMATIQUE, INC., ET AL.	§	CASE NO. 2:10-CV-570
GUCCI AMERICA, INC., ET AL.	§	CASE NO. 2:10-CV-571
RENT-A-CENTER, INC., ET AL.	§	CASE NO. 2:10-CV-573
ROYAL PURPLE INC, ET AL.	§	CASE NO. 2:10-CV-575
YAKIRA, LLC, ET AL.	§	CASE NO. 2:10-CV-587
WHERE 2 GET IT INC., ET AL.	§	CASE NO. 2:11-CV-175
EYE CARE CENTERS OF AMERICA, INC.	§	CASE NO. 2:11-CV-404
AMERCO, ET AL.	§	CASE NO. 2:11-CV-421
7-ELEVEN, INC., ET AL.	§	CASE NO. 2:11-CV-424
SUNBELT RENTALS, INC.	§	CASE NO. 2:11-CV-425
CANON, INC., ET AL.	§	CASE NO. 2:12-CV-043
AMERICAN APPAREL INC.	§	CASE NO. 2:12-CV-436
ABERCROMBIE & FITCH CO.	§	CASE NO. 2:12-CV-437
AMERICAN EAGLE OUTFITTERS INC..	§	CASE NO. 2:12-CV-438
ANN INC.	§	CASE NO. 2:12-CV-439
BURLEIGH POINT LTD.	§	CASE NO. 2:12-CV-441
CATALOGUE VENTURES, INC.	§	CASE NO. 2:12-CV-442
BURBERRY LIMITED	§	CASE NO. 2:12-CV-443
BURLINGTON FACTORY WAREHOUSE CORPORATION	§ §	CASE NO. 2:12-CV-444
CACHE INC.	§	CASE NO. 2:12-CV-445
THE WILLIAM CARTER COMPANY	§	CASE NO. 2:12-CV-446
CHARMING SHOPPES INC.	§	CASE NO. 2:12-CV-447
CHICO'S FAS INC.	§	CASE NO. 2:12-CV-448
CITI TRENDS INC.	§	CASE NO. 2:12-CV-449
CLAIRE'S BOUTIQUES, INC.	§	CASE NO. 2:12-CV-450
COLDWATER CREEK INC.	§	CASE NO. 2:12-CV-451
DAVID'S BRIDAL INC.	§	CASE NO. 2:12-CV-452

DELIAS INC.	§ CASE NO. 2:12-CV-454
DIESEL U.S.A. INC.	§ CASE NO. 2:12-CV-456
DONNA KARAN INTERNATIONAL, INC.	§ CASE NO. 2:12-CV-457
LVMH MOET HENNESSY LOUIS VUITTON, INC.	§ CASE NO. 2:12-CV-458
DOTS, LLC	§ CASE NO. 2:12-CV-459
DRAPER'S & DAMON'S INC.	§ CASE NO. 2:12-CV-460
EDDIE BAUER LLC	§ CASE NO. 2:12-CV-461
ESPRIT US RETAIL LIMITED	§ CASE NO. 2:12-CV-462
THE FINISH LINE INC.	§ CASE NO. 2:12-CV-464
FOREVER 21 RETAIL INC.	§ CASE NO. 2:12-CV-465
FORMAL SPECIALISTS LTD.	§ CASE NO. 2:12-CV-466
FREDRICK'S OF HOLLYWOOD STORES, INC.	§ CASE NO. 2:12-CV-467
GROUPE DYNAMITE, INC. D/B/A GARAGE	§ CASE NO. 2:12-CV-468
GUESS? RETAIL INC.	§ CASE NO. 2:12-CV-469
H&M HENNES & MAURITZ LP	§ CASE NO. 2:12-CV-470
HANESBRANDS INC.	§ CASE NO. 2:12-CV-471
HOT TOPIC INC.	§ CASE NO. 2:12-CV-472
HUGO BOSS FASHION INC.	§ CASE NO. 2:12-CV-473
J. CREW GROUP INC.	§ CASE NO. 2:12-CV-474
JIMMY JAZZ INC.	§ CASE NO. 2:12-CV-475
JOS. A. BANK CLOTHIERS INC.	§ CASE NO. 2:12-CV-476
ALCO STORES INC.	§ CASE NO. 2:12-CV-477
BROWN SHOE COMPANY INC.	§ CASE NO. 2:12-CV-480
COLLECTIVE BRANDS INC.	§ CASE NO. 2:12-CV-481
CROCS INC.	§ CASE NO. 2:12-CV-482
DSW INC. D/B/A DSW SHOE INC.	§ CASE NO. 2:12-CV-483
GENESCO INC.	§ CASE NO. 2:12-CV-486
HEELY'S INC.	§ CASE NO. 2:12-CV-487
AMERICAN GREETING CORPORATION	§ CASE NO. 2:12-CV-520
HALLMARK CARDS, INC.	§ CASE NO. 2:12-CV-521
HICKORY FARMS INC.	§ CASE NO. 2:12-CV-522
SPENCER GIFTS LLC	§ CASE NO. 2:12-CV-523
INTERNATIONAL COFFEE & TEA, LLC	§ CASE NO. 2:12-CV-524
THINGS REMEMBERED, INC.	§ CASE NO. 2:12-CV-525
THE YANKEE CANDLE COMPANY, INC.	§ CASE NO. 2:12-CV-526
BOSE CORPORATION	§ CASE NO. 2:12-CV-527
GUITAR CENTER INC.	§ CASE NO. 2:12-CV-528
24 HOUR FITNESS WORLDWIDE INC.	§ CASE NO. 2:12-CV-530
BALLY TOTAL FITNESS CORPORATION	§ CASE NO. 2:12-CV-531
BARE ESSENTIALS INC.	§ CASE NO. 2:12-CV-532
BIOSCRIP INC.	§ CASE NO. 2:12-CV-533

CRABTREE & EVELYN	§	CASE NO. 2:12-CV-534
CURVES INTERNATIONAL INC.	§	CASE NO. 2:12-CV-535
GOLD'S GYM INTERNATIONAL INC.	§	CASE NO. 2:12-CV-536
GREAT CLIPS INC.	§	CASE NO. 2:12-CV-537
L.A. FITNESS INTERNATIONAL INC.	§	CASE NO. 2:12-CV-538
LIFE TIME FITNESS INC.	§	CASE NO. 2:12-CV-539
M.A.C. COSMETICS INC.	§	CASE NO. 2:12-CV-540
MERLE NORMAN COSMETICS	§	CASE NO. 2:12-CV-541
VITAMIN COTTAGE NATURAL FOOD MARKETS, INC.	§ §	CASE NO. 2:12-CV-542
REGIS CORPORATION	§	CASE NO. 2:12-CV-543
SALLY BEAUTY SUPPLY LLC	§	CASE NO. 2:12-CV-544
SEPHORA USA INC.	§	CASE NO. 2:12-CV-545
ULTA SALON, COSMETICS & FRAGRANCE, INC.	§	CASE NO. 2:12-CV-547
VITAMIN SHOPPE INDUSTRIES, INC.	§	CASE NO. 2:12-CV-548
EYEMART EXPRESS, LTD.	§	CASE NO. 2:12-CV-549
LUXOTTICA RETAIL NORTH AMERICA INC.	§	CASE NO. 2:12-CV-550
NATIONAL VISION INC.	§	CASE NO. 2:12-CV-551
U.S. VISION INC.	§	CASE NO. 2:12-CV-552
BUTH-NA-BODHAIGE INC.	§	CASE NO. 2:12-CV-555
PSP GROUP, LLC	§	CASE NO. 2:12-CV-556
WHERE 2 GET IT INC.	§	
V.	§	CASE NO. 2:12-CV-149
GEOTAG, INC.	§ §	

### **MEMORANDUM OPINION AND ORDER**

Before the Court is Defendants' Opposed Motion for Leave to Supplement Invalidity Contentions, filed November 27, 2012.<sup>1</sup> The Court having considered the same finds that the

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<sup>1</sup> Defendants' have filed the motion in multiple cases as follows: Case No. 2:10-cv-265, Dkt. No. 353; Case No. 2:10-cv-272, Dkt. No. 141; Case No. 2:10-cv-569, Dkt. No. 186; Case No. 2:10-cv-570, Dkt. No. 554; Case No. 2:10-cv-571, Dkt. No. 466; Case No. 2:10-cv-573, Dkt. No. 362; Case No. 2:10-cv-575, Dkt. No. 572; Case No. 2:10-cv-587, Dkt. No. 379; Case No. 2:11-cv-175, Dkt. No. 358; Case No. 2:11-cv-404, Dkt. No. 435; Case No. 2:11-cv-421, Dkt. No. 82; Case No. 2:11-cv-424, Dkt. No. 85; Case No. 2:11-cv-425, Dkt. No. 75; Case No. 2:12-cv-43, Dkt. No. 95; Case No. 2:12-cv-149, Dkt. No. 83; Case No. 2:12-cv-436, Dkt. No. 52; Case No. 2:12-cv-437, Dkt. No. 49; Case No. 2:12-cv-438, Dkt. No. 46; Case No. 2:12-cv-439, Dkt. No. 50; Case No. 2:12-cv-441, Dkt. No. 51; Case No. 2:12-cv-442, Dkt. No. 48; Case No. 2:12-cv-443, Dkt. No. 52; Case No. 2:12-cv-444, Dkt. No. 48; Case No. 2:12-cv-445, Dkt. No. 48; Case No. 2:12-cv-446, Dkt. No. 48; Case No. 2:12-cv-447, Dkt. No. 47; Case No. 2:12-cv-448, Dkt. No. 48; Case No. 2:12-cv-449, Dkt. No. 48; Case No. 2:12-cv-450, Dkt. No. 48; Case No. 2:12-cv-451, Dkt. No. 52; Case No. 2:12-cv-452, Dkt. No. 47; Case No. 2:12-cv-454, Dkt. No. 47; Case No. 2:12-cv-456, Dkt. No. 49; Case No. 2:12-cv-457, Dkt. No. 49; Case No. 2:12-cv-458, Dkt. No. 50; Case No. 2:12-cv-459,

motion should be **DENIED**.

## **I. Applicable Law**

A party's invalidity contentions are deemed to be the party's final invalidity contentions unless amendment or supplementation is permitted by the Local Patent Rules. P.R. 3-6. In limited circumstances, amendment of invalidity contentions is permitted as of right. P.R. 3-6(a). Otherwise, amendment "may be made only by order of the Court, which shall be entered only upon a showing of good cause." P.R. 3-6(b). When determining whether a party has demonstrated good cause, the Court considers: (1) the explanation for the party's failure to meet the deadline; (2) the importance of the amendment; (3) potential prejudice from allowing the amendment; and (4) the availability of a continuance to cure such prejudice. *S & W Enters., L.L.C. v. SouthTrust Bank of Alabama, NA*, 315 F.3d 533, 536 (5th Cir. 2003).

## **II. Discussion**

Defendants served their invalidity contentions on August 17, 2012. By the present motion, Defendants seek leave pursuant to Patent Rule 3-6(b) to supplement their invalidity contentions to include 36 additional prior art references describing the following five prior art

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Dkt. No. 55; Case No. 2:12-cv-460, Dkt. No. 47; Case No. 2:12-cv-461, Dkt. No. 48; Case No. 2:12-cv-462, Dkt. No. 47; Case No. 2:12-cv-464, Dkt. No. 48; Case No. 2:12-cv-465, Dkt. No. 49; Case No. 2:12-cv-466, Dkt. No. 47; Case No. 2:12-cv-467, Dkt. No. 49; Case No. 2:12-cv-468, Dkt. No. 47; Case No. 2:12-cv-469, Dkt. No. 47; Case No. 2:12-cv-470, Dkt. No. 48; Case No. 2:12-cv-471, Dkt. No. 49; Case No. 2:12-cv-472, Dkt. No. 48; Case No. 2:12-cv-473, Dkt. No. 47; Case No. 2:12-cv-474, Dkt. No. 62; Case No. 2:12-cv-475, Dkt. No. 47; Case No. 2:12-cv-476, Dkt. No. 47; Case No. 2:12-cv-477, Dkt. No. 48; Case No. 2:12-cv-480, Dkt. No. 48; Case No. 2:12-cv-481, Dkt. No. 48; Case No. 2:12-cv-482, Dkt. No. 48; Case No. 2:12-cv-483, Dkt. No. 47; Case No. 2:12-cv-486, Dkt. No. 47; Case No. 2:12-cv-487, Dkt. No. 47; Case No. 2:12-cv-520, Dkt. No. 45; Case No. 2:12-cv-521, Dkt. No. 48; Case No. 2:12-cv-522, Dkt. No. 45; Case No. 2:12-cv-523, Dkt. No. 51; Case No. 2:12-cv-524, Dkt. No. 44; Case No. 2:12-cv-525, Dkt. No. 48; Case No. 2:12-cv-526, Dkt. No. 45; Case No. 2:12-cv-527, Dkt. No. 45; Case No. 2:12-cv-528, Dkt. No. 44; Case No. 2:12-cv-530, Dkt. No. 44; Case No. 2:12-cv-531, Dkt. No. 42; Case No. 2:12-cv-532, Dkt. No. 43; Case No. 2:12-cv-533, Dkt. No. 43; Case No. 2:12-cv-534, Dkt. No. 44; Case No. 2:12-cv-535, Dkt. No. 45; Case No. 2:12-cv-536, Dkt. No. 44; Case No. 2:12-cv-537, Dkt. No. 44; Case No. 2:12-cv-538, Dkt. No. 46; Case No. 2:12-cv-539, Dkt. No. 44; Case No. 2:12-cv-540, Dkt. No. 49; Case No. 2:12-cv-541, Dkt. No. 44; Case No. 2:12-cv-542, Dkt. No. 45; Case No. 2:12-cv-543, Dkt. No. 50; Case No. 2:12-cv-544, Dkt. No. 48; Case No. 2:12-cv-545, Dkt. No. 44; Case No. 2:12-cv-547, Dkt. No. 45; Case No. 2:12-cv-548, Dkt. No. 45; Case No. 2:12-cv-549, Dkt. No. 44; Case No. 2:12-cv-550, Dkt. No. 45; Case No. 2:12-cv-551, Dkt. No. 50; Case No. 2:12-cv-552, Dkt. No. 44; Case No. 2:12-cv-555, Dkt. No. 44; Case No. 2:12-cv-556, Dkt. No. 44. For brevity, the Court cites only to the briefing filed in Case No. 2:10-cv-265.

systems: (1) EAAsy Sabre; (2) Prodigy; (3) America On Line (“AOL”); (4) CompuServe; and (5) Delphi (collectively “the Supplemental References”). According to Defendants, their “first inkling” of the relevance of the Supplemental References came on September 5, 2012, when Defendants’ counsel received an email from co-counsel stating that “he had gone through some old boxes of books while cleaning out his garage and came across [an early AOL User Guide].” (Dkt. No. 353 at 5, Ex. 1 ¶ 4.) Defendants thereafter searched for earlier versions of the AOL User Guide, as well as additional similar references relating to online Internet service providers. On November 12, 2012, Defendants disclosed the Supplemental References to Plaintiff GeoTag, Inc. (“GeoTag”).

The Court is not persuaded that Defendants have acted diligently in discovering such Supplemental References. The Defendants should have, at the least, timely uncovered the AOL User Guide that triggered Defendants’ search into the Supplemental References because it had been in the possession of Defendants’ counsel. While Defendants argue that “it is often more difficult to identify web-based prior art” (Dkt. No. 353 at 8), the Supplemental References here are not obscure internet references but include what might well be described as the largest and most popular internet systems of the 1980s and 1990s. Indeed, Defendants did not appear to encounter any difficulty in finding and attaining the references once the discovery of the AOL User Guide prompted the search. (*See* Dkt. No. 353 Ex. 1 ¶¶ 4-7.) Moreover, the patent-in-suit itself discloses both AOL and Compuserve, and Defendants’ original invalidity contentions cited a system that explicitly ran on Prodigy. Ultimately, Defendants’ only explanation for its untimely invalidity contentions is that counsel happened upon a reference while cleaning out his garage. Such happenstance discovery in these circumstances does not demonstrate the diligence necessary to support the late supplementation now requested. In the Court’s view, to hold

otherwise would render “the explanation for the party’s failure to meet the deadline” a non-factor.

### **III. Conclusion**

Based on the foregoing reasons, the Court finds that Defendants’ Opposed Motion for Leave to Supplement Invalidity Contentions should be and is hereby **DENIED**.

**So ORDERED and SIGNED this 11th day of June, 2013.**

  
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RODNEY GILSTRAP  
UNITED STATES DISTRICT JUDGE